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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,614	12/12/2003	Jean Renard Ward	P0916D	1705

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DIGIMARC CORPORATION
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EXAMINER

TURCHEN, JAMES R

ART UNIT	PAPER NUMBER
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2139

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/734,614

Applicant(s)

WARD, JEAN RENARD

Examiner

James Turchen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claims 1-41 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow et al. (US 6,292,092) in view of Chen et al. (US 5,694,471).

Regarding claims 1 and 5:

Chow et al. discloses an identification document comprising a photographic representation of a bearer of the identification document (figure 2, item 2) and indicia provided on the document (figure 2, item 1), the identification document further comprising a security feature printed on a surface of the identification document in a two-dimensional symbology (figure 2, item 3), the security feature including: a first set of information corresponding to at least one of the identification document, the bearer of

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the identification document (figure 2, item 1 shows the bearers information in plain text) and an issuer of the identification document (figure 2, examiner interprets the Canadian flag as an identification of the issuer), wherein the first set of information comprises an unencrypted form; and a cryptographic measure associated with the first set of information (column 4 lines 62-67). Chow et al does not disclose the cryptographic measure identifying at least a record of fabrication for the identification document. Chen et al. discloses an issuer identification number (column 7 lines 37-48) that is used in a public/private key pair (column 8 lines 9-21). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the identification document disclosed by Chow et al. with the record of fabrication used in the cryptographic measure in order identify who issued the document.

Regarding claim 2:

Chow et al. and Chen et al. disclose the identification document of claim 1, wherein the record of fabrication identifies at least one of equipment used in fabricating the identification document, an identification document assembler, a distribution channel and an operator of document fabrication equipment (Chen et al. discloses the issuer identification number. It is inherent that the issuer identification number discloses the operator of document equipment (either an individual or organization)).

Regarding claim 3:

Chow et al. discloses in figure 2, item 1 that the set of information comprises an identification number, name, birth date, and blood type (physical attribute).

Regarding claim 4:

Chow et al. discloses the two-dimensional symbology comprises a 2-D barcode (figure 2, column 3 lines 1-2).

Regarding claims 6 and 7:

Chow et al. and Chen et al. disclose the identification document of claim 1. The use of certificates with public/private key pairs is inherent in the art. Additionally, the certificate comprising a public key for decrypting is also inherent in the art.

Regarding claims 8 and 9:

Chow et al. and Chen et al. disclose the identification document of claim 6, but they do not disclose the use of multiple key pairs. It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate multiple private keys (which would incorporate multiple signatures) allowing for cascaded encryption that would further encrypt the information.

Regarding claims 10 and 11:

Chow et al. discloses the cryptographic measure comprises a hash of at least the first set of information and a second set of information (item 1 and 2, column 3 lines 43-51). The hash is later encrypted by the private key (column 5 lines 1-6).

Regarding claim 12:

Chow et al. discloses the second set of information comprises a condensed representation of the photographic representation (column 5 lines 65-66).

Regarding claim 13:

Chow et al. discloses in figure 2, item 1 an identification number (an identification number is unique to the ID and therefor can be used as an inventory number, where it is

located). It would have been obvious to one of ordinary skill in the art to move the identification number from section 1 to section 2 using either an overlay or a displaying the ID number at a side of the picture.

Regarding claim 14:

Chow et al. discloses the indicia comprises at least text and a barcode (figure 2).

Regarding claims 15, 18, 19, and 26:

Chow et al. discloses a method of analyzing an identification document, the identification document comprising a first set of information and a cryptographic signature corresponding to the first set of information, wherein the first set of information and the cryptographic signature are encoded in a machine-readable format, the encoding being printed or engraved on a surface of the identification document, said method comprising: machine-sensing the first set of information and the cryptographic signature (column 5 lines 9-30); and determining fabrication details of the identification document from at least the cryptographic signature (examiner interprets this to mean if the ID is authentic via the ID's signature, column 5 lines 9-30; it is inherent that the document's signature is correct or the document will be considered fraudulent; the use of certificates is inherent in public/private key pair methods; It is common to sign a document with the creator's/manufacture's signature in order to identify authenticity of the document and verify it is a trusted origin and it would have been obvious to one of ordinary skill in the art at the time of invention to sign with the creator's/manufacture's signature).

Regarding claims 16 and 17:

Chow et al. discloses digital watermarking in the form of a two-dimensional symbology (figure 2, item 3).

Regarding claim 20:

Chow et al. discloses the method of claim 19, but does not disclose the method of determining whether the certificate has been revoked. It would have been obvious to one of ordinary skill in the art to check a trusted third party to find out the authenticity and status of the certificate.

Regarding claim 21:

Chow et al. inherently discloses the use of certificates through the use of public/private key pairs. It is inherent to check the date of the certificate in order to ensure that the certificate has not expired. If the certificate is not valid, then the signature is not valid.

Regarding claims 22 and 23:

Chow et al. discloses the method of claim 18 and the use of asymmetric keys (column 5 lines 1-6), but does not disclose the use of symmetric keys or the use of a trusted third party. It would have been obvious to one of ordinary skill in the art at the time of invention to check the authenticity and status of the certificate with a trusted third party, as it is common with certificates and public/private key pairs. Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention to use a symmetric key in order to make key computation and signatures computationally less intensive.

Regarding claims 24 and 25:

Chow et al. discloses the method of claim 18, but does not disclose the information that the certificates contain. It would have been obvious to include the information about manufacturing/creating the document in the document's certificate.

Regarding claims 27 and 28:

Claims 27 and 28 are similar to claims 15-25 and are therefor rejected under the same reasoning.

Regarding claims 29 and 32:

A method to establish whether an identification document should be trusted comprising: randomly or pseudo-randomly selecting a unique serial number; associating the unique serial number and fabrication details in a data record; providing the unique serial number on the identification document; and issuing the identification document (examiner interprets the following steps as a method of creating an identification document; Chow et al. discloses an identification document with a document number in figure 2, item 1; it is inherent to generate a serial number, assign a serial number to a item, record the item, serial number, and fabrication details (creation date/issue date/completion date, issuer, etc.) in a database, and to issue the item).

Regarding claims 30 and 31:

Chow et al. discloses the identification number as a form of text in section 1 of figure 2. Chow et al. further discloses using the information in section 1 as an input to generate the barcode (figure 2, section 3) in column 3 lines 43-51.

Regarding claims 33-40:

Claims 33-40 are similar to claims 15-25 and are therefor rejected under the same reasoning.

Regarding claim 41:

The authentic equipment (examiner interprets equipment as the set of equipment used to produce and authenticate) of Chow et al. comprises a fabricator (column 7 lines 57-63) and a scanner (column 8 lines 39-51).

Claim Objections

2. Claim 29 objected to because of the following informalities: Claim 29 states "a method to establish whether an identification document should be trusted" when the steps within the claims list creating, logging, and issuing a serial number. Appropriate correction is required.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses identification, watermarking, and revocation systems.

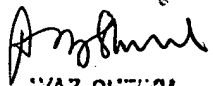
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Turchen whose telephone number is 571-270-1378. The examiner can normally be reached on MTWRF 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on 571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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